

Application No. 09/058,170
Response dated May 1, 2006
Office Action mail date: January 31, 2006

Atty. Docket No. 13296/3
PATENT APPLICATION

REMARKS/ARGUMENTS

Claims 1, 4-13, 16-25, 28-37, and 40-82 are pending in the application.

Claims 1, 11-13, 23-25, 35-37, 47-49, 51, 53, 55, 57, 58, 67-70, and 79-82 are rejected under 35 U.S.C. § 103(a) as being unpatentable over USP 5,675,756 (Benton) in view of USP 6,069,629 (Paterson). Claims 49, 51, 53, 55, 58, and 70 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Benton in view of Paterson and further in view of USP 5,535,321 (Massaro).

Claims 4-10, 16-22, 28-34, 40-46, 50, 52, 54, 56, 59-66, and 71-78 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form. While Applicants appreciate the Examiner's indication of allowable subject matter, Applicants respectfully decline the Examiner's invitation at this time.

Applicants respectfully traverse the Examiner's rejection, and request reconsideration and allowance of the claims in view of the following arguments.

The language which Applicants added to the rejected claims in the present application came from the following portion of the second full paragraph on page 8 of the Board decision mailed August 25, 2004:

We do not agree with appellants' argument that the phrase "parameters of the program" as used in claim 1 requires the modification of parameters as used by the program for its internal operation or must relate to installing and updating a program within the context of a particular operating system.

Applicants interpret the Board's decision as meaning that one of two distinctions is significant with respect to patentability of the claims: 1) modification of parameters as used by

Atty. Docket No. 13296/3
PATENT APPLICATION

Application No. 09/058,170
Response dated May 1, 2006
Office Action mail date: January 31, 2006

the program for its internal operation; or 2) installing and updating a program within the context of a particular operating system.

1) Modification of parameters as used by the program for its internal operation

Independent claims 1, 13, 25, and 37 recite, among other things, parameters used by a computer program for its internal operation. This language specifies the claimed parameters. The claims go on to recite the setting and/or changing of these parameters, and thus recite the modification of these parameters, which are the parameters as used by the program for its internal operation.

In the discussion on page 3 of the Office Action, the Examiner cites portions of Benton which the Examiner asserts teach "displaying a window to the user providing information regarding parameters of the program used by the program for its internal operation". In particular, the Examiner refers to Fig. 2 of Benton, and MCUI 300, as well as physical parameters 32, 34, 36, and 38 in Fig. 1, and the associated discussion at col. 6, lines 16-24 and 35-36.

Applicants respectfully submit that none of this discussion specifies parameters of the program that are used by the program for its internal operation. This was a key point of contention during the prior appeal. While the prior Examiner pointed to the same portions of Benton to which the current Examiner now points (compare page 3 of the present Office Action with page 5 of the Examiner's Answer), the Board nowhere indicated that Benton met the presently-claimed limitation.

Moreover, it is not just this claim language by itself identifying the parameters in question, but also the subsequent claim language that talks about setting and/or changing these

Application No. 09/058,170
Response dated May 1, 2006
Office Action mail date: January 31, 2006

Atty. Docket No. 13296/3
PATENT APPLICATION

parameters, that is missing from Benton. On pages 4 and 5 of the Office Action, similarly to pages 5 and 6 of the Examiner's Answer, the present Examiner refers to Paterson as providing teaching relative to setting and/or changing of parameters. However, Applicants submit that nothing in Paterson deals with setting and/or changing of parameters used by the program in its internal operation.

The Board had all these particular portions of Benton and Paterson presented and argued directly, but still focused on the language which forms the boldface header 1) earlier in this paper. Applicants submit that these portions of Benton and Paterson fail to teach or suggest the subject matter of independent claims 1, 13, 25, or 37.

On page 9 of the Office Action, the Examiner has cited some portions of Paterson (col. 17, lines 15-54; col. 18, lines 10-63, and col. 2, lines 32-38) as providing allegedly relevant teaching. However, a detailed review of these portions of Paterson likewise yields no relevant teaching or suggestion of parameters as claimed in independent claims 1, 13, 25, and 37, and thus no relevant teaching or suggestion of setting and/or changing such parameters. Therefore, Applicants submit that these claims and their dependencies (claims 11, 12, 23, 24, 35, 36, 47, and 48) are patentable.

2) Installing and updating a program within the context of a particular operating system

Independent claims 57, 69; 81, and 82 recite, among other things, at least one of several tasks which are stated to relate to installing or updating a program within a context of an operating system.

Application No. 09/058,170
Response dated May 1, 2006
Office Action mail date: January 31, 2006

Atty. Docket No. 13296/3
PATENT APPLICATION

The Examiner discusses these claims (Office Action, page 5) as having limitations similar to those of claims 1, 13, 25, and 37. However, as noted in the preceding discussion, claims 1, 13, 25, and 37 recite modification of parameters used by the system for its internal operation. Claims 57, 69, 81, and 82 do not contain such recitation. As the Examiner notes in the paragraph bridging pages 5 and 6 of the Office Action, claims 57, 69, 81, and 82 recite, among other things, "wherein said at least one of said loading, installation, migration, fallback, remigration, and update tasks relate to installing or updating the program within a context of an operating system". The Examiner relies on Figs. 3 and 4 of Paterson as allegedly supplying this teaching.

Applicants respectfully disagree. Fig. 3 of Paterson shows a software structure core 52. Fig. 4 shows interaction of that core with two different GUIs, one GUI 82 operating on a Macintosh® platform, another GUI 82 operating on a Windows® platform and another GUI 84, coded in HTML or Java, that is platform-independent. The prior Examiner cited these same items in the paragraph bridging pages 12 and 13 of the Examiner's Answer. Thus, just as with the other portions of the prior art, the Board had this teaching from Paterson argued directly in front of it. The Board still focused on the language which forms the boldface header 2) earlier in this paper.

That a GUI operates on one platform or another – or indeed in a platform-independent context, as Paterson notes (col. 4, lines 52-62) does not teach or suggest installing or updating a program within the context of an operating system, as claimed.. Applicants submit that these portions of Paterson fail to teach or suggest the subject matter of independent claims 57, 69, 81,

Application No. 09/058,170
 Response dated May 1, 2006
 Office Action mail date: January 31, 2006

Atty. Docket No. 13296/3
PATENT APPLICATION

or 82. Therefore, Applicants submit that independent claims 57, 69, 81, and 82 and their respective dependencies (claims 58-68 and claims 70-80) are patentable.

Request for Allowance

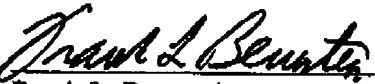
It is believed that this Response places the application in condition for allowance, and early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the telephone number listed below.

The Office is hereby authorized to charge any fees, or credit any overpayments, to
 Deposit Account No. **11-0600**.

Respectfully submitted,
 KENYON & KENYON LLP

Dated: May 1, 2006

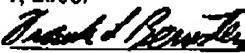
By: 
 Frank L. Bernstein
 Reg. No. 31,484

Customer No. **61023**

KENYON & KENYON LLP
 333 West San Carlos St., Suite 600
 San Jose, CA 95110
 Telephone: (408) 975-7500
 Facsimile: (408) 975-7501

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this paper is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on May 1, 2006.


 Frank L. Bernstein